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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------------|
| 09/669,196 | 09/25/2000 | Philip Carragher | Carr-P2-00 | 2986 |
| 28710 | 7590 | 09/03/2008 | | |
| PETER K. TRZYNA, ESQ. P O BOX 7131 CHICAGO, IL 60680 | | | EXAMINER KARMIS, STEFANOS | |
| | | | ART UNIT 3693 | PAPER NUMBER |
| | | | MAIL DATE 09/03/2008 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/669,196

Applicant(s)

CARRAGHER ET AL.

Examiner

STEFANOS KARMIS

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The following communication is in response to Applicant's amendment filed 27 May 2008.

Status of Claims

2. Claims 1, 8, 36-43, 55 and 56 are currently amended. Claims 1-56 are pending.

Response to Arguments

3. Applicant's arguments filed 27 May 2008 have been fully considered but they are not persuasive.
4. Regarding claims 1-56, Applicant argues that Sullivan fails to teach the amended limitations of claim 1, which states that the external residential expense that has been selected by a cardholder from a plurality of external residential expense options. The Examiner respectfully disagrees. Sullivan teaches, that the cardholder has a plurality of external residential expense options such as fire insurance, flood insurance, home insurance, mortgage insurance, etc. (column 6, lines 38-50). Further, Sullivan teaches that the cardholder selects which one of these insurance options will be associated with the card. Specifically Sullivan teaches that the cardholder provides to the card issuer information of the insurance account number that will be the beneficiary account and that the insurance account number is linked or associated with the credit card or debit card account (column 9, lines 4-22). Sullivan teaches the cardholder could choose to have fire insurance linked to the credit/debit card, flood insurance linked to the

credit/debit card, home insurance linked to the debit/card, mortgage insurance linked to the credit/debit card, etc. Therefore, Sullivan teaches that the cardholder selects which one of the insurance products to associate with the card from a plurality of external residential expense options and crediting according to the external residential option that has been selected (column 6, lines 38-59 and column 8, lines 5-50, column 9, lines 4-57). Claim 1 is representative of the amendments made to the other amended claims and therefore they remain rejected under the same reasoning as claim 1.

5. Regarding the rejection of claims 27, 36, 40 and 41, Applicant provides no arguments why Sullivan in view of Petit is not a proper combination and therefore this argument is moot.
6. Regarding the rejections using Official Notice, Applicant has requested that a reference be provided. Therefore the Examiner is providing support below within the body of the rejection for claims rejected under Official Notice.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-4, 7, 8, 11, 38, 39, 42, 43 and 45-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Sullivan U.S. Patent 6,386,444.

Regarding claim 1, 38, 42, 43, 55 and 56, Sullivan discloses a computer-aided method for card-activity based residential expense crediting, the method comprising: associating card activity with an external residential expense (column 5, line 66 thru column 6, line 18 and column 6, lines 38-59; associated with home insurance/mortgage insurance); crediting an amount to the external residential expense responsive to the card activity (column 6, lines 38-59 and column 8, lines 5-50; Examiner also notes that the crediting could simply be paying the insurance with the credit card); and generating output including external residential expense crediting (column 6, lines 38-59 and column 8, lines 5-50).

Claim 2, applying some of the amount in a funds transfer to pay the expense (column 7, lines 51 thru column 8, line 3).

Claim 3 and 4, wherein the associating card activity with an external residential expense includes the entering external mortgage identifying data; and carryout out the crediting according to the data (column 7, lines 1-22).

Claim 7, 11, wherein the external residential expense is insurance (column 6, lines 38-59).

Regarding claim 8 and 39, Sullivan discloses a computer-aided method for card-activity based residential expense crediting, the method comprising; associating card activity with an external residential expense (column 5, line 66 thru column 6, line 18 and column 6, lines 38-59; associated with home insurance/mortgage insurance); crediting an amount to the external residential expense responsive to the card activity (column 6, lines 38-59 and column 8, lines 5-50; Examiner notes that the payment is applying some of the amount such as 1%); and generating output including external residential expense crediting (column 6, lines 38-59 and column 8, lines 5-50).

Claim 45-54, obtaining identifying data for the external residential expense; and wherein the crediting is carried out with amount comprising a reward (column 5, line 66 thru column 6, line 18 and column 6, lines 38-59).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 27, 36, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan U.S. Patent 6,386,444 in view of Petit U.S. Patent 4,722,554.

Claims 27, 36, 40 and 41, Sullivan teaches a computer-aided method for card-activity based residential expense crediting, the method comprising; associating card activity with an external residential expense (column 5, line 66 thru column 6, line 18 and column 6, lines 38-59; associated with home insurance/mortgage insurance); crediting an amount to the external residential expense responsive to the card activity (column 6, lines 38-59 and column 8, lines 5-50; Examiner notes that the payment is applying some of the amount such as 1%); and generating output including external residential expense crediting (column 6, lines 38-59 and column 8, lines 5-50).

Sullivan fails to specify printing a check for the amount; printing a coupon with the amount for carrying out the payment of the mortgage with the check; and combining the check and the coupon with a statement of the card activity in an envelope so as to address the envelope to the cardholder. Pettit teaches an alternative value paper refund form in which a negotiable instrument, nominally a check, and one or more coupons. The form is typically used for a rebate or refund (column 3, lines 30-47 and column 9, lines 3-25). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Sullivan and include payment through postage because it is an efficient manner to transmit payment information stemming from a rebate or refund and is extremely well known in the financial and billing arts.

11. Claims 5, 6, 9, 10, 12-26, 28-35 and 44 were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan U.S. Patent 6,386,444 in view of Official Notice. Support is provided below for these rejections.

12. Claims 5, 6, 9, 10, 37 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan U.S. Patent 6,386,444 in view of Hastings U.S. Patent 6,751,596.

Claims 5, 6, 9, 10, 37 and 44, Sullivan teaches wherein the external residential expense is insurance (column 6, lines 38-59). Sullivan fails to teach that the external residential expense is a closing cost or downpayment or an actual mortgage. Hastings teaches a system and method for tracking, monitoring and supporting self-procuring principals in real estate transactions that take closing costs, downpayments and mortgages into account (column 15, lines 36-50). Hastings further teaches that downpayments and closing costs are major impediments to purchasing a home (column 1, lines 15-32). Therefore it would have been obvious to one of ordinary skill in the art to modify the teachings of Sullivan to include closing costs or downpayments because they are external residential expenses needing to be paid by the customer and the customer would thus have an incentive to use the card to provide payments for these expenses to apply to these costs to help with the purchase of a home.

13. Claims 12-26 and 28-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan U.S. Patent 5,966,699 in view of Johnson U.S. Patent 6,999,943.

Regarding claims 12-26 and 28-35, Sullivan fails to teach the processing and applying of payment as discussed in these claims. Johnson teaches multiple payment methods (Abstract, column 24, lines 60 thru column 25, line 8). Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of

Sullivan to include the processing and application of payments by various methods because it provides a system desirable to the customer by giving the customer options on how to process and apply payments to that the system can better meet the needs of the parties involved in the transactions.

14. Claims 5, 6, 9, 10, 37 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan U.S. Patent 5,966,699 in view of Zandi U.S. Patent 5,966,699.

Claims 37, Sullivan teaches a computer-aided method for card-activity based residential expense crediting, the method comprising; associating card activity with an external residential expense (column 5, line 66 thru column 6, line 18 and column 6, lines 38-59; associated with home insurance/mortgage insurance); crediting an amount to the external residential expense responsive to the card activity (column 6, lines 38-59 and column 8, lines 5-50; Examiner notes that the payment is applying some of the amount such as 1%); and generating output including external residential expense crediting (column 6, lines 38-59 and column 8, lines 5-50). Sullivan fails to teach auctioning a proposed new mortgage. Zandi teaches lenders participating in an auction for a new mortgage (column 3, lines 55-67 and column 7, line 8 thru column 9, line 54). Therefore it would have been obvious to one of ordinary skill in the art to modify the teachings of Sullivan to include the mortgage auctioning teaching of Zandi because it provides for obtaining a loan with more favorable terms for the borrower and thus helps the borrower obtain the mortgage.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEFANOS KARMIS whose telephone number is (571)272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted
/Stefanos Karmis/
Primary Examiner, Art Unit 3693
29 August 2008